



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/675,999   | 10/02/2003  | Tatsuji Nagaoka      | 243435US90          | 7779             |
| 22850  | 7590        | 02/06/2008           |                     |                  |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| RYAN, PATRICK A  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 4126   |             |                      |                     |                  |
| NOTIFICATION DATE  |             | DELIVERY MODE        |                     |                  |
| 02/06/2008   |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

# Office Action Summary

**Application No.**

10/675,999

**Applicant(s)**

NAGAOKA ET AL.

**Examiner**

PATRICK A. RYAN

**Art Unit**

4126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-6 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 02 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s) Mail Date 10/20/03, 5/4/05, 7/19/07  
4) ☐ Interview Summary (PTO-413)  
Paper No(s) Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is the First Action based on the 10/675999 application filed October 2, 2003. As originally filed, Claims 1-6 are presented for examination.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan (P2002-302260) on October 16, 2002.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 through 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Koplar et al. (US Patent Application Publication 2002/0112250) hereinafter "Koplar."
5. In regards to Claim 1, Koplar teaches a system comprising a broadcast station apparatus (as disclosed in Paragraph [0063] "in a system of the invention... composite video signals are received and projected by a display device..." Koplar's system must inherently comprise a broadcast station apparatus with the capability of transmitting a

signal to the receiver of the display device. In addition, Koplar discloses in Paragraph [0073] Lines 19-25 "the composite video signal comprises a video signal modulated with auxiliary data..." with further reference to system operation described in Paragraph [0106] Lines 2-10. The Examiner interprets Koplar's "composite video signal" to be equivalent to the Applicant's claimed "multiplexing signal" because both consist of broadcast program information (Koplar's 'video signal') and contents information (Koplar's 'auxiliary data').

Koplar further teaches and a television set (display device 10 of Fig. 1, as described in Paragraph [0063]), the television comprises: a multiplexing signal receiver ("Video signals receivable by display device include those delivered by microwave relay, satellite retransmission or cable, streaming or other types of downloadable or viewable computer video presentations, and those generally made available by wired or wireless methods." as disclosed in Paragraph [0064] Lines 14-19, as received by antenna 84, as described in Paragraph [0074] Lines 12-16) configured to receive the multiplexing signal (composite video signal received by display device, as described in Paragraph [0106] Lines 1-10); a separator configured to separate the broadcast program information and the contents information from the received multiplexing signal (decoder box 82 shown in Fig. 12, as described in Paragraph [0074] Lines 3-16); a reproducer configured to reproduce the broadcast program information ("display device [is] capable of providing not only image information in a visible mode but also auxiliary information (i.e., data) in a substantially transparent mode" as disclosed in Paragraph [0064] Lines 4-6, Koplar's system must therefore inherently include a reproduction means in order to display the

video information once this information has been discriminated from the composite video signal); and a transmitter configured to transmit the contents information to a mobile terminal during the reproducing of the broadcast program information ("Decoder box 82 discriminates the auxiliary data and transfers it to the hand-held device 12 by RF or by other means..." as disclosed in Paragraph [0074] Lines 4-6; in addition "Decoder box 82 contains antenna 84 so that it may transmit RF signals between it and the hand-held device" as disclosed in Paragraph [0074] Lines 12-14).

6. In regards to Claim 2, Koplar teaches a contents providing system according to Claim 1, wherein the multiplexing signal transmitter of the broadcast station apparatus transmits the multiplexing signal (this limitation has been addressed with reference to Claim 1) multiplexing each of a plurality of contents data on the broadcast program information, the contents information being divided into the plurality of contents data independently (Composite video signal comprise two frequency signals: a 16kHz NTSC and an 8kHz signal that contains the auxiliary data as disclosed in Paragraph [0100]); the separator of the television set separates the broadcast program information and the plurality of contents data from the received multiplexing signal (this limitation has been addressed with reference to Claim 1); the transmitter of the television set transmits the plurality of contents data to the mobile terminal during the reproducing of the broadcast program information (this limitation has been addressed with reference to Claim 1).

7. In regards to Claim 3, Koplar teaches a contents providing system according to Claim 1, wherein the mobile terminal comprises a request transmitter ("Decoder box [82] may also function as a two-way device, so that it may receive feedback from the hand-held device" as disclosed in Paragraph [0075] Lines 4-6, therefore Koplar's hand-held device must inherently comprise a request transmitter in order to conduct two-way communication with decoder box 82. In addition, hand-held device 12 as comprises RF antenna 68 of Fig. 6 that would also facilitate two way communications to the display device 10.) configured to transmit an information provision request to the television set during the reproducing of the broadcast program information (i.e. "Users, upon receipt of information such as a television schedule on their hand-held device, may transmit a request to the decoder box or VCR to schedule the recoding of a television program" as disclosed in Paragraph [0075] Lines 12-15; or during a live broadcast: "television viewers direct their sports device 12S at display device 10 to... configure their device so that they may receive the auxiliary data" as disclosed in Paragraph [0092] Lines 1-5); the television set comprises the information provision request receiver configured to receive the information provision request (decoder box 82, as described in Paragraph [0075] Lines 4-6); and the transmitter of the television set transmits the contents information in accordance with reception of the information provision request in the information provision request receiver during the reproduction of the broadcast program information (i.e. "sports fans may get live statistics and trivia through use of their hand-held device 12 while they watch the game live and at home" as disclosed in Paragraph [0092] Lines 10-15).

8. In regards to Claim 4, Koplar teaches a contents providing system according to Claim 2, wherein the television set comprises an information provision request receiver (decoder box 82, as described in Paragraph [0075] Lines 4-6) configured to receive an information provision request form the mobile station during the reproducing of the broadcast program information (i.e. "Users, upon receipt of information such as a television schedule on their hand-held device, may transmit a request to the decoder box or VCR to schedule the recoding of a television program" as disclosed in Paragraph [0075] Lines 12-15; or during a live broadcast: "television viewers direct their sports device 12S at display device 10 to... configure their device so that they may receive the auxiliary data" as disclosed in Paragraph [0092] Lines 1-5); the transmitter of the television set transmits the contents data in accordance with reception of the information provision request in the information provision request receiver during the reproducing of the broadcast program information (i.e. "sports fans may get live statistics and trivia through use of their hand-held device 12 while they watch the game live and at home" as disclosed in Paragraph [0092] Lines 10-15).

9. In regards to Claim 5, Koplar teaches a mobile terminal (i.e. sports device 12S of Fig. 13E, as described in Paragraph [0091]) comprising a receiver (RF antenna 68 of Fig. 13E, as described in Paragraph [0091]; with further reference to FM receiver 62 of Fig. 16, as described in Paragraph [0107] Lines 11-24) configured to receive a plurality of contents data transmitted from a television set ("initiate operation of hand-held device

Art Unit: 4126

12... such as by holding hand-held device 12 so that the leading edge 18 is generally towards display device 10" as disclosed in Paragraph [0091] Lines 7-12) during the reproducing of broadcast program information (i.e. "sports fans may get live statistics and trivia through use of their hand-held device 12 while they watch the game live and at home" as disclosed in Paragraph [0092] Lines 10-15); and a creator configured to create contents information based on the plurality of contents data during the reproducing of the broadcast program information (LCD 44 of Fig. 13E, as described in Paragraph [0091] Lines 5-7; composite video signals may be received by photosensor 30 to drive LCD 44, as disclosed in Paragraph [0107] Lines 5-9).

10. In regards to Claim 6, Koplar teaches the mobile terminal according to Claim 5, the mobile terminal further comprising a request transmitter ("Decoder box [82] may also function as a two-way device, so that it may receive feedback from the hand-held device" as disclosed in Paragraph [0075] Lines 4-6, therefore Koplar's hand-held device must inherently comprise a request transmitter in order to conduct two-way communication with decoder box 82. In addition, hand-held device 12 as comprises RF antenna 68 of Fig. 6 that would also facilitate two way communications to the display device 10.) configured to transmit an information provision request to the television set during the reproducing of the broadcast program information (i.e. "Users, upon receipt of information such as a television schedule on their hand-held device, may transmit a request to the decoder box or VCR to schedule the recoding of a television program" as disclosed in Paragraph [0075] Lines 12-15; or during a live broadcast: "television



viewers direct their sports device 12S at display device 10 to... configure their device so that they may receive the auxiliary data" as disclosed in Paragraph [0092] Lines 1-5); and wherein the receiver receives the contents data transmitted from the television set in accordance with reception of the information provision request during the reproducing of the broadcast program information (i.e. "sports fans may get live statistics and trivia through use of their hand-held device 12 while they watch the game live and at home" as disclosed in Paragraph [0092] Lines 10-15).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).
12. US Patent Number (6,993,781 B2) Terakado et al. teach a remote control device with the capability to receive program data, such as television guide listings that can then be used to schedule a recording reservation to a video tape recorder.
13. US Patent Number (7,086,081 B2) Martinez et al. teach a wireless personal information management (IM) unit that interfaces with a docking station. The IM unit is operated to selectively and individually communicate with the docking station to access

and retrieve more detailed information related to a presentation being made in a live presentation.

14. US Patent Number (7,296,282 B1) Koplar et al. teach a method of and system for transmitting and receiving a composite video signal, which comprises a video broadcast and auxiliary data. The auxiliary data may then be transferred to a hand-held device, such as a "smart card" wherein the user can then receive benefits that may be contained in the auxiliary data, such as merchandise coupons.

15. US Patent Application Publication (2003/0023977) Brown et al. teach a method of providing additional program information to a user, through wireless means, on a hand-held computing device.

16. US Patent Application Publication (2003/0093813) Shintani et al. teach a bi-directional communications link between a television set and a remote control unit. The television set has the capability send the remote control unit a listing of electronic programming guide information.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Ryan whose telephone number is (571) 270-5086. The examiner can normally be reached on Mon to Thur, 8:00am - 5:00pm EST.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 4126

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick A Ryan/

Examiner, Art Unit 4126

Tuesday, February 05, 2008

/Lun-Yi Lao/

Primary Examiner, Art Unit 2629